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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/932,677 | 08/16/2001 | Donald F. Weaver | NCI-006DV1 | 5945 |

959 7590 12/04/2002

LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

EXAMINER

RAO, DEEPAK R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1624

DATE MAILED: 12/04/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/932,677

Applicant(s)
Weaver et al.

Examiner
Deepak Rao

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 16, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-142 ☒ are pending in the application.
- 4a) Of the above, claim(s) 70-77, 79, 81-91, 94-117, and 120-137 ☒ are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68, 69, 78, 80, 92, 93, 118, 119, and 138-142 ☒ are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

This office action is in response to the amendment filed on September 16, 2002.

Claims 68-142 are pending in this application.

Election/Restriction

Based on the elected species of 3-amino-3[3-(4-chlorophenoxy)-phenyl]-propionic acid, claims 68-69, 78, 80, 92-93, 118-119, 138-140 and 141-142 are under examination in the instant application, for the reasons provided in the previous office action(s).

Claims 70-77, 79, 81-91, 94-117 and 120-137 are withdrawn as being drawn to nonelected species.

The following rejections are withdrawn:

The rejections under 35 U.S.C. 112, second paragraph of the previous office action are withdrawn in view of the amendments and applicant's remarks.

The following rejections are maintained:

1. Claims 68-69, 78, 80, 92, 93 and 138-142 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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application was filed, had possession of the claimed invention. The reasons provided in the previous office action are incorporated here by reference.

Applicant relies on the amendment to overcome the rejection which is not deemed to be sufficient. The claims still recite “a **substituted** β -amino anionic compound” which allows substitution anywhere in the compound. All the subgeneric structures and examples provided in the specification relate mainly to $A-CHR'-CHR'-NR_aR_b$, wherein other than the amino group and the anionic group, only two R' groups are disclosed. The instant recitation in the claims include compounds having more than one substituent each at the α - and the β -carbons. Applicant directs attention to page 4, lines 18-20, however, this disclosure relates to the formula shown at line 15 wherein there is only R_1 substituent on the β -carbon, which is not sufficient to support the instant recitation of ‘substituted β -amino anionic acid’.

Applicant refers to the disclosure at page 14, line 28 and argues that the specification teaches that ‘the β -amino anionic compound may have any substituent that an alkyl group may have’. However, the specification at page 14, line 28 states that “each R' can independently be hydrogen or any substituent of an alkyl group as defined above” with reference to the formula $A-CHR'-CHR'-NR_aR_b$. Therefore, it does not support for ‘substituted β -amino anionic acid’ having multiple substituents as recited in the claims.

Further, the instant recitation of ‘substituted β -amino anionic acid’ in claim 68 does not specify what “anionic” group is intended. Applicant refers to page 3, lines 2-6 for support wherein following the recitation of ‘ β -amino anionic acid’ it clearly sets forth the anionic groups.

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The instant claim is broader than the disclosure because the claim does not set forth which anionic groups are intended.

2. Claims 68-69, 78, 80, 92-93 and 138-142 are rejected under 35 U.S.C. 102(b) as being anticipated by Weaver et al., WO 98/40055, for the reasons provided in the previous office action which are incorporated here by reference.

Applicant relies on the filing date of the parent application 09/041,371 filed March 11, 1998 to overcome the reference. However, as indicated above, the instant claims are not deemed to meet the requirements of 35 U.S.C. 112, first paragraph and therefore, are not entitled for the filing date of the parent application.

3. Claims 68-69, 78, 80, 92, 93, 118-119 and 141 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-19 of U.S. Patent No. 6,306,909, for the reasons provided in the previous office action which are incorporated here by reference.

It is acknowledged that 'applicants will consider filing a Terminal Disclaimer upon finding that the claims are otherwise in condition for allowance'.


Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


Deepak Rao
Primary Examiner
Art Unit 1624

December 2, 2002